

Remarks :

The above Amendments and these Remarks are in reply to the Office Action mailed May 27, 2003 (“Office Action”) in patent application Serial No. 10/085,782.

Claims 10, 11, 19, 20, 24 and 25 have been allowed.

The Examiner has indicated claim 9 would be allowable if rewritten in independent form. As suggested by the Examiner, claim 9 has been rewritten in independent form and is believed allowable.

Claims 1-3, 16 and 22 have been cancelled. Claims 4, 6, 9, 11-15, 17, 20-21, 23 and 25-27 have been amended. Allowed claims 11, 20 and 25 have been amended by adding a comma.

In the Office Action, claims 1-8, 12-18 and 28-31 are rejected under 35 U.S.C. §102(b) as being anticipated by *Zerbe et al.* (U.S. Patent No. 6,111,445).

Claims 21-23 and 26-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Zerbe et al.*

I. Rejection of Claims 4-8, 12-15, 17-18 and 28-31 Under 35 U.S.C. §102(b)

Claims 4-8, 12-15, 18 and 28-31 are rejected under 35 U.S.C. §102(b) as being anticipated by *Zerbe et al.*

A. Claims 4 and 15

In rejecting amended claims 4 and 15, the Examiner stated that *Zerbe et al.* teaches “a first control circuit ([transistors] 2313, 2312, 2315)” and “a second control circuit ([transistors] 2314, 2311, 2317)” as seen in Fig. 21. Office Action, page 3. The Examiner then goes on to state that “a third transistor” and “a fourth transistor” of claims 4 and 15 are taught by the same transistors –transistors 2311 and 2312—used by the Examiner in teaching “a first control circuit” and “a second control circuit.”

Independent claims 4 and 15, as well as claim 21, calls for distinct elements, “a first control circuit”, “a second control circuit”, “a third transistor” and “a fourth transistor” which are not taught by *Zerbe et al.* The Examiner is improperly using the same transistors 2311 and 2312 for two distinctly claimed elements. A proper anticipation analysis requires the “allegedly invalidating prior art contain ‘each and every element of [the] claimed invention.’ *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000). The Examiner can not properly use transistors 2311 and

2312 to teach **both** the “first control circuit” and “second control circuit” as well as “a third transistor” and “fourth transistor”, respectively, of claims 4 and 15.

B. Claims 5-8 and 17-18

Claims 5-8 and 17-18 depend from independent claims 4 and 15, respectively, and therefore are patentable for at least the same reasons stated above.

C. Claims 12-14

Claims 12-14 have been amended to depend from allowed claim 11 and therefore are patentable for at least the same reasons for allowing claim 11.

D. Claims 28-31

Independent claim 28 calls for a specific method according to an embodiment of the present invention.

The Examiner rejected claim 28 stating:

...[T]his claim is merely a method to operate the circuit having elements and connections discussed in claim 1 above, since *Zerbe* teaches the circuit, he inherently teaches the recited method. Office Action, page 6.

First, as described above, the circuit shown in Fig. 21 does not teach independent claim 4; therefore, the method to operate the circuit is not inherent.

Second, the Examiner has not shown where *Zerbe et al.* teaches “obtaining a clock signal” and “applying a first voltage from the clock signal to a first transistor....” as required by the first two steps of claim 28. The Examiner has the burden of showing with particularity where and how these claimed method steps are taught by *Zerbe et al.*

Claims 29-31 ultimately depend from claim 28 and are therefore patentable for at least the same reasons described above.

Claim 29 calls for “applying the first voltage to a third transistor” and “applying the second voltage to a fourth transistor.” The Examiner has not identified with particularity the “first voltage”, “second voltage” and the respective applying to “a first transistor”, “a second transistor”, “a third transistor” and “a fourth transistor.”

Further, claim 31 calls for an additional step of using currents “to provide a duty cycle correction signal” that is clearly not taught or suggested by *Zerbe et al.*

Accordingly, it is respectfully requested the Examiner withdraw the rejection of claims 4-8, 12-15, 18 and 28-31 under 35 U.S.C. §102(b).

II. Rejection of Claims 21, 23 and 26-27 Under 35 U.S.C. §103(a)

Claims 21, 23 and 26-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Zerbe et al.*

A. Claims 21

Claim 21 calls for distinct elements, “a first control circuit”, “a second control circuit”, “a third transistor” and “a fourth transistor” which are not taught by *Zerbe et al.* as described above and therefore is patentable.

B. Claims 23

Claim 23 has been amended to depend from claim 21 and therefore is patentable for at least the same reasons as stated above in regard to claim 21.

C. Claims 26-27

Claims 26-27 have been amended to depend from allowed claim 25 and therefore are patentable for at least the same reasons stated above in regard to claim 25.

Accordingly, it is respectfully requested the Examiner withdraw the rejection of claims 21, 23 and 26-27 under 35 U.S.C. §103(a).

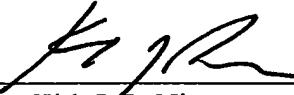
III. Conclusion

Based on the above amendments and these remarks, reconsideration of claims 4-9, 12-15, 17-18, 21, 23, 26-31 is respectfully requested.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: August 27, 2003

By: 

Kirk J. DeNiro
Reg. No. 35,854

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 Market Street, Suite 540
San Francisco, California 94105-4206
Telephone: (415) 369-9660 x204
Facsimile: (415) 369-9665